



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,291	01/08/2004	Foy Streetman	S-00019-022	7595

25178 7590 07/22/2010  
A PATENT LAWYER CORP, PLC  
R WILLIAM GRAHAM  
3340 ROSEWOOD LN  
OKLAHOMA CITY, OK 73120

EXAMINER
----------

BEKERMANN, MICHAEL

ART UNIT	PAPER NUMBER
----------	--------------

3622

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

07/22/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

bill@apatentlawyercorpplc.com  
apatentlawyer@hotmail.com  
info@apatentlawyercorpplc.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/753,291	<b>Applicant(s)</b> STREETMAN, FOY	
	<b>Examiner</b> MICHAEL BEKERMAN	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 42-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

This action is responsive to papers filed on 3/22/2010.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 42-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Regarding claim 42**, this claim recites the limitation "allowing said tree to grow". What, however, does a step of "allowing" entail? What steps should be taken to "allow" a tree to grow? Is this a step of non-interference, and if so, how does someone actively not interfere in the growing of a tree? Is the step of not keeping a tree from growing actually a step to be performed? This is unclear. Claims 43-49 inherit this rejection through dependency from claim 42.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**2. Claims 42-49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

**Regarding claims 42-49**, based on Supreme Court precedent, a method/process claim must **(1)** be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or **(2)** transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method or process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**3. Claims 42-49 are rejected under 35 U.S.C. 102(a) as being anticipated by Farmers Union (“Forestry Contract”, Farmers Union Carbon Credit Program, found online at**

**“<http://www.urbanforestrysouth.org/resources/library/carbon-credit-program-forestry-offsets-from-tree-plantings-reforestation/file>”, document made available to the public on at least January 1, 2003 according to Page 3).** Farmers Union teaches a method of reforestation that includes all of the limitations recited in the above claims.

**Regarding claim 42**, Farmers Union teaches offering a reforestation service with carbon credit consumer symbols assigned and enclosed within a media document (numerous items within the document could read on a CCCP, including the Farmers Union logo on the front page, or the term “CO<sub>2</sub>” contained in numerous locations throughout the document). Farmers Union further teaches how the process of forestation will comprise planting trees, natural regeneration (allowing the tree to grow), and creating a carbon credit value (“Forestation” section on Page 4, majority of Page 5, Table on Page 7, Table on Page 8).

**Regarding claims 43-45**, Farmers Union has multiple displayed images throughout the document. It is a document that is meant to be printed out, and since the document is attachable to other items via staple, glue, or other binding agents, it is also considered to be a tag.

**Regarding claims 46 and 47**, Farmers Union includes tables and formulas for calculating the value of carbon credits to be assigned (Pages 8-12). Farmers Union is, itself, a presentation that enables a purchase of the service.

**Regarding claims 48 and 49**, Farmers Union discloses reforesting degraded land (Forestation section on Page 4). Merriam Webster defines reforestation as “the action of renewing forest cover”. This would include replanting of trees that were removed (harvested).

### ***Response to Arguments***

4. Applicant argues that the claimed method is useful and should therefore overcome the 101 rejection. However, the usefulness of the method is not what is at issue. To overcome the 101 rejection with regard to Bilski, a claim must identify a critical step as being performed by a computer. Currently, there is no computer set forth in the claim language, and therefore claim 42 is still rejected under 35 U.S.C. 101.

All other arguments are moot in view of the new grounds of rejection.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3622

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMAN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Thursday, 9:00 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Bekerman/  
Primary Examiner, Art Unit 3622